REMARKS

This paper is filed in response to the Restriction Requirement set forth in the Office action (Paper No. 20070420) mailed on 9 May 2007, reconsideration and re-examination are respectfully requested.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), this listing of the claims, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

Claim 6 is amended, and claims 15 through 20 are newly added.

Status of the Claims

Claims 1 and 3 through 20 are pending in the application.

Requirement for Restriction - 37 CFR §1.142

In the Restriction Requirement set forth in the Office action, the Examiner required a restriction under 35 U.S.C. §121 and 37 CFR §1.142, between:

- **Group I** covered by claims 1, 3 through 6, drawn to a magnesium titanate implant and;
- **Group II** covered by claims 7 through 14 drawn to a process for preparing a magnesium titanate oxide film implant.

Applicants respectfully traverse the election requirement imposed in the Office action, but provisionally elect **Group II** covered by claims 7 through 14, which the Examining staff has determined is drawn to a magnesium titanate implant, together with newly presented claims 15 through 20 directed to the elected subject matter of **Group II**.

Applicant objects to and traverses the restriction requirement on the grounds that the subject matter of the two groups overlap. In addition, it appears that the restriction requirement is being imposed merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

As specifically stated in MPEP §803, in imposing a restriction requirement, the Examiner must show that:

> (A) the inventions are independent (*see* MPEP §802.01, §806.04, §808.01) or distinct as claimed (*see* MPEP §806.05 - §806.05(i)); **and**
>
> (B) there will be a **serious burden** on the Examiner if the restriction requirement is not imposed (*see* MPEP §803.02, §806.04(a) -§806.04(i),§808.01(a), and §808.02). It is respectfully submitted that there would **not be a serious burden** upon the Examiner in searching Groups I and II.

The Examiner has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner **must examine the application on the merits**, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in imposing the requirement and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement cannot be made final according to MPEP §706.07.

MPEP §806.03 states that:

> "Where the claims of an application define the same essential

> characteristics of a *single* disclosed embodiment of an invention, restriction therebetween **should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition" (emphasis supplied).

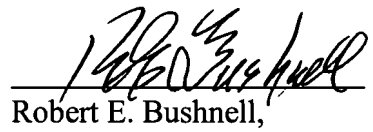
Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed? That fact that Applicant's claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant's inventions, is not a basis for violating this prohibition against restriction. In support of this restriction, the Examiner wrote that " the special technical feature of Group I is an implant body containing titanium or titanium oxide coated with magnesium titanate oxide file. The special technical feature of Group II is use of UV light in combination with a dipping step to produce a coated titanium or titanium alloy body. These statement are no accurate in view of the presentation of claims 15 through 18 which depend upon non-elected Group I to define the subject matter of elected Group II, and the presentation of claims 19 and 20 dependent upon non-elected Group I to define the subject matter of elected Group II. Withdrawal of this requirement is therefore respectfully urged.

For the above reasons, it is respectfully submitted that the restriction requirement is unnecessary, is not in accordance with the Rules of Practice or the *Manual of Patent Examining Proceedure*, and constitutes the imposition of an undue burden and unfair expense upon the Applicants. Therefore, the restriction requirement should be withdrawn. If the requirement for restriction is not withdrawn, then the Applicants reserve the right to file a Petition to the Commissioner.

In view of the foregoing demonstration of the impropriety of this requirement, it is requested that the restriction requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

No fee is incurred by this Response.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408.9040
FAX: 202.289.7100

Folio: P57712
Date: 6/5/07
I.D.: REB/nm